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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,476	07/01/2002	Jorg Peter Schur	von Kreisler.021	3376

110 7590 01/20/2004

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER

LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1616

10

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



**UNITED STATES DEPARTMENT OF COMMERCE
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DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 10/3/03

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-52 is/are pending in the application.

Of the above, claim(s) 27-50 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-26, 51, 52 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-52 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

Applicant's election without traverse of Group II in Paper No. 10/03/03 is acknowledged. However; specific species of Olipophilic and (2)hydrophilic Gras agents, (3) of added Gras agents were not elected, thus, the compounds in each group are presumed to be considered as equivalent. We find spraying, wheat and Rapeseed oil to meet the additional species election requirements listed as 4, 5, 6 of 8/01/03 office actions.

Claims 27-50 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10/03/03.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-26, 51, 52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There claims are beyond the scope of the specification, which provides only limited compositions of specific ratios of 5 compounds in water or Rapeseed oil, applied unspecified as to pre or post harvest, effective in 2 tests of undeterminable microbial nature. The multitude of claimed inventions, without specific guidance as to combination of critical components ratios and amounts applied at specific growth stages

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of specific plants to protect against specific microbes requires more testing than one of ordinary skill in the art would be expected to perform in order to determine whether or not any claimed composition in fact protects plants when applied post harvest. Note that no composition actually prevented microbial growth.

The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factor are: (1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction of guidance presented; (7) the presence of absence of working examples; and (8) the quantity of experimentation necessary. When the above factors are weighed, it is the examiner's position that instant disclosure fails to meet the enablement requirement for the following reasons;

(1) The nature of the invention: claims are to unquantified (some require O) ratios/amounts of compounds to post harvest plants, then protected from microbes, the invention is seen as prophetic expectations of various compositions.

(2) The state of the prior art : use of these compounds for non-specific protection-experimentation was required.

(3) The relative skill of those in the art

The relative skill of those in the art is at the experiments level of a horticulturist.

(4) The predictability or unpredictability of the art

The unpredictability of the art is very high.

(5) The breadth of the claims

They are beyond attainment,

(6) The amount of direction or guidance presented. Standard protocols are used, but of foreign origin and not presented

(7) The presence or absence of working examples

No specific microbe is shown to be prevented to attach any plant, pre or post harvest.

(8) The quantity of experimentation necessary; extensive

There are no showings of effects for any combination of ingredients of less than the 5 of the examples; there are no showings of efficacy of claim 8 alcohols.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5, 6, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by
McArdle-5747416.

The treatment of plants with the instant compositions, by spraying is disclosed, in order to provide improved growth and pest protection-see claims 22, 34 post harvest (efficacy is up to 2 years-col.11, bottom). Plants –flowers-are specifically protected

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(claim 37). Components utilized are tannic acid, lactic acid acidulants (col.7, top) in aqueous or organic solvent system of propylene glycol.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26, 50, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beilfuss et al CA 2012288 and Nakano-JP 3121036 in view of Bessette et al WO 98/54971.

Regular use in horticulture to prevent microbial infestations; thus, inclusive of the instant after harvest application (p.1) are known to include alcohols, phenols, here, essential oils and phenol GRAS compounds are used (Thymol p. 4, lines 16-20) and benzylalcohol, and phenylethyl alcohol (lines 21-25, p.4), with acid (p.5 top). Nothing is said about propylene glycol, specifically. Nakano, however, provides multi component plant extracts of plants containing benzyl alcohol, with tammins, tannic acid and propylene glycol and acids-sothic, acetic see abstracts.

The compositions are applied to plants, protecting against antimicrobials.

Bessette also applies Benzyl alcohol to plants, among other GRAS compounds, and protects against insects. All compounds are GRAS or less toxic than standard chemical pesticides/antimicrobials, thus environmentally preferred.

Thus, the artisan would find it obvious to prepare particular ingredient combinations, and sizes, concentration and ratios of ingredients, depending upon the

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target species, desired number of applications, length of time for desired protection, ease of handling, target species, degradation, for example.

It has not clearly been established by objective showing of some unobvious and/or unexpected results that the administration of the particular form of active, carrier, of the time to be treated provides any greater level of prior art expectation as claimed. Further, no criticality as to the particular compound or mixes thereof has been shown by applicant.

The selection of each ingredient and amount thereof is a result effective parameter chosen to obtain the desired effects. It would be obvious to vary the nature of each ingredient to optimize the effects desired, and the use ingredients for the functionality for which they are known to be used is not a basis for patentability.

It would have been obvious to one with ordinary skill in the art at the time of the instant invention, to arrive at a composition of the instant components since all the teachings referenced show their use. The specific weights, and additives are result effective parameters subject to control by one with skill in the art.

Motivation to combine teachings is shown in the art; both insect and microbial pests can be controlled with these ingredients, in one application to plants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is 308-2412. The examiner can normally be reached on Tuesday- Friday 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-273-0602. The fax phone number

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for the organization where this application or proceeding are assigned are (703) 308-4556 and (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Levy/tgd

January 6, 2004

A handwritten signature in black ink, appearing to read "Neil S. Levy". The signature is fluid and cursive, with the first name "Neil" and last name "Levy" clearly distinguishable.

NEIL S. LEVY
PRIMARY EXAMINER